



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/748,698

12/22/2000

Franco Travostino

120-201

4557

34845 7590 11/02/2010  
Anderson Gorecki & Manaras LLP  
33 NAGOG PARK  
ACTON, MA 01720

EXAMINER

EL CHANTI, HUSSEIN A

ART UNIT

PAPER NUMBER

2441

NOTIFICATION DATE

DELIVERY MODE

11/02/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

handerson@smmalaw.com  
officeadmin@smmalaw.com  
cmorrisette@smmalaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/748,698	<b>Applicant(s)</b> TRAVOSTINO, FRANCO	
	<b>Examiner</b> HUSSEIN A. EL CHANTI	<b>Art Unit</b> 2441	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-15,17-26 and 28-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7,9-15,17-19,28 and 30-36 is/are allowed.
- 6) ☒ Claim(s) 20-26,29 and 37-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

***Response to Amendment***

1. This action is responsive to amendment received Sep. 13, 2010.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 37-46 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 37-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are ambiguously constructed and indeterminate in scope because they purport to claim both a system and method.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 20-26, 28 and 37-46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 20-25 and 28 are rejected as computer programs per se, i.e., the descriptions or expressions of the programs. Such programs are not physical "device or structure" nor are they statutory processes, as they are not "acts" being performed. The

computer programs do not define any structural and functional interrelationships between the computer program and other claimed aspects of the invention which permit the computer program's functionality to be realized. A claim to a non-transitory computer storage medium encoded with functional descriptive material that can function with a computer to effect a practical application that results in a useful, concrete and tangible result would be statutory. An amendment to claim 20 to clearly state the computer program is stored on a non-transitory computer storage medium which is executed by a computer to perform steps comprising, would overcome the 35 U.S.C. rejection.

Claims 37-46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 37-46 embrace or overlap two separate statutory classes of invention set forth in 35 U.S.C. 101 in a single claim. A claim of this type is precluded by the express language of 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. Each statutory class of claims must be considered independently on its own merits, see *Ex parte Lyell* (BdPatApp&Int) 17 USPQ2d 1548 *Ex Parte Lyell*.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee, U.S. Patent No. 6,061,563 in view of Abramson et al., U.S. Patent No. 6,539,494 (referred to hereafter as Abramson).

As to claim 42, Lee teaches a terminal device accesses a communication network through one of a plurality of access point devices that implement a first protocol layer of a wireless communication protocol and a back end device that implements a first protocol layer of the wireless communication protocol, a method for using information related to the terminal device, the method comprising: saving information for the terminal device by the back end device; and using the saved information to facilitate establishment of connectivity with a first wireless access point (see col. 3 lines 44-col. 4 lines 35).

As to claim 43, Lee teaches the method of claim 42, wherein using the saved information comprises: using the saved information for accounting purposes (see col. 3 lines 44-col. 4 lines 35).

As to claim 44, Lee teaches the method of claim 42, wherein using the saved information comprises: using the saved information for network management purposes (see col. 3 lines 44-col. 4 lines 35).

As to claim 45, Lee teaches the method of claim 42, wherein using the saved information comprises: using the saved information for user tracking purposes (see col. 3 lines 44-col. 4 lines 35).

As to claim 46, Lee teaches the method of claim 42, wherein using the saved information comprises: using the saved information for user locating purposes (see col. 3 lines 44-col. 4 lines 35).

5. Claims 1-7, 9-15, 17-19, 28 and 30-36 are allowable over prior art of record.

***Response to Arguments***

6. Applicant's arguments have been fully considered but are not persuasive. Applicant argues in substance that A) the rejection of claims 37-46 under 35 U.S.C. 101 is improper; B) Lee and Abramson do not teach repairing or preventing failure of the backed up device as in claims 42-46.

In response to A) Claims 37 and 42 recite in the preamble: "In a communication system... the method comprising". It is not clear whether the claims are method or system claims. Therefore, the rejection is proper. In addition, an amendment to the claims to recite either a method or a system would clearly define the claims and would overcome the 35 U.S.C. 101 rejections.

In response to B) The argued limitations are not in the claims. Claimed subject matter not the specification is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding prior art. In re Sporck, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1986); In re Self, 213 USPQ 1, 5 (CCPA 1982); In re Priest, 199 USPQ 11, 15 (CCPA 1978).

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUSSEIN A. EL CHANTI whose telephone number is (571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan can be reached on (571)272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2441

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hussein El-chant/  
Primary Patent Examiner

Oct. 27, 2010